

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : Cary Lee Bates et al.
Application No. : 10/816,705
Filed : April 2, 2004
For : METHOD OF REMOTELY CONTROLLING SET TOP
BOX VIA TELEPHONE, COMPUTER-READABLE
STORAGE MEDIUM STORING INSTRUCTIONS
FOR SAME AND APPARATUS USING A
TELEPHONE INTERFACE
Examiner : Jun Fei Zhong
Art Unit : 2426

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Dear Sir:

In response to the decision of the Examiner in the Final Office Action dated April 8, 2008, finally rejecting claims 1-7 and 9-14, a Notice of Appeal was filed on July 8, 2008.

Appellants/Applicants submit the following Brief on Appeal in compliance with 37 CFR § 41.37. For the reasons more fully set forth below, it is respectfully submitted that the final rejections of claims 1-7 and 9-14 should be reversed.

REAL PARTY IN INTEREST:

The real party in interest is INTERNATIONAL BUSINESS MACHINES CORPORATION, the assignee of the subject application.

RELATED APPEALS AND INTERFERENCES:

Appellants/Applicants and Appellants/Applicants' legal representative do not know of any prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by, or have a bearing on, the Board's decision in this appeal.

STATUS OF CLAIMS:

Claims 1-7 and 9-14 have been rejected and are on appeal.

STATUS OF AMENDMENTS:

An Amendment after the Final Office Action (request for reconsideration) was filed on June 9, 2008. The request was considered as indicated by the Advisory Action mailed on June 26, 2008.

SUMMARY OF CLAIMED SUBJECT MATTER:

Claim 1

Claim 1 is directed to a method of controlling a set top box. The method comprises providing a set top box that can be controlled by a telephone line coupled to the set top box (as discussed in the specification, for example, on pages 5-6, lines 9-15). The method further comprises receiving a telephone call from a calling party via the telephone line (as discussed in the specification, for example, on pages 18-19, lines 25-21). The method further comprises controlling the set top box via at least one command transmitted by the calling party to the set top box during the telephone call, the controlling including directing the set top box to tune to a television event in accordance with the at least one command (as discussed in the specification, for example, on pages 21-22, lines 7-8).

Claim 12

Claim 12 is directed to an apparatus adapted to employ a telephone interface. The apparatus comprises a processor comprising computer program code adapted to control a set top box via at least one command transmitted by a calling party over a telephone line coupled to the set top box, the command being transmitted during a telephone call, the controlling including directing the set top box to tune to a television event in accordance with the at least one command (as discussed in the specification, for example, on pages 5-6, lines 23-2, and pages 21-22, lines 7-8).

Claim 14

Claim 14 is directed to a computer readable storage medium encoded with processing instructions for causing a processor to execute a method of controlling a set top box. The method comprises controlling a set top box via at least one command transmitted by a calling party over a telephone line coupled to the set top box, the command being transmitted during a telephone call, the controlling including directing the set top box to tune to a television event in accordance with the at least one command (as discussed in the specification, for example, on pages 5-6, lines 23-2, and pages 21-22, lines 7-8).

"Means" Or "Step"

None of the claims contain an element expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL:

Claims 1-5 and 12-14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,671,267 to August et al. [hereinafter *August*]. Claims 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of U.S. Patent No. 6,772,436 to Doganata et al. Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of U.S. Patent Publication No. 2005/0028208 to Ellis et al. Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of U.S. Patent No. 5,640,453 to Schuchman. Claim 11 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of U.S. Patent No. 6,219,355 to Brodigan.

ARGUMENT:

REVIEW OF *AUGUST*

August relates "to a cordless telephone having a portable unit arranged for providing control functions for remotely operated devices." *August*, col. 1, lines 10-12. *August* discusses an arrangement that includes a set-top box 32 attached to a video receiving device 60 and a handset. *August*, col. 10, lines 46-65. The set-top box receives signals from a video service network 40. *August*, Fig. 5. *August* teaches remotely accessing the set-top box "for altering the configuration of [the set-top box]." In one example, *August* teaches limiting programs that the set-top box can receive by entering codes that enable a first or second set of channels to reach the video receiving device. *August*, Col. 10, lines 45-57.

The cited passages of *August* do not discuss directed a set top box to tune to a television event in accordance with at least one command.

**A PRIMA FACIE CASE OF ANTICIPATION HAS NOT BEEN ESTABLISHED
AS THE OFFICE ACTIONS FAIL TO ESTABLISH THAT *AUGUST* DISCLOSES
DIRECTING A SET TOP BOX TO TUNE TO A TELEVISION EVENT IN ACCORDANCE
WITH AT LEAST ONE COMMAND**

Appellants/Applicants respectfully submit that the record fails to establish that each feature of independent claims 1, 12, and 14 is disclosed by *August*. Accordingly, Appellants/Applicants respectfully submit that the record fails to establish a prima facie case of anticipation.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *MPEP* § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Id.* (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Further, "[t]he elements must be arranged as required by the claim..." *Id.* (citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Independent claim 1 recites, inter alia,

controlling the set top box via at least one command transmitted by the calling party to the set top box during the telephone call, the controlling including directing the set top box to tune to a television event in accordance with the at least one command.

Independent claims 12 and 14, which each have their own scope, recite similar features.

Appellants/Applicants respectfully submit that the cited passages of *August* fail to disclose at least the above feature. Specifically, Appellants/Applicants respectfully submit that the cited passages of *August* fail to discuss tuning to a television event.

The above expressly-recited claim feature clearly recites directing the set top box to tune to a television event in accordance with the at least one command. The Office Actions contend that *August* discloses this feature. Specifically, at page 2, the Final Office Action contends "a user could access the set top box remotely and enable/disable certain channels deliver[ed] to [the] display device (i.e., ordering the set top box tuning to certain channels or not tuning to) by enter[ing] the predetermined codes..."

Appellants/Applicants respectfully submit that *August* merely teaches enabling sets of channels to reach the video receiving device. Absent from *August* is any teaching of tuning to a television event via a command. Stated another way, enabling a set of channels to reach a video receiving device is not tuning to a television event.

Further, enabling a set of channels to reach a video receiving device is not tuning to a television event *in accordance with the at least one command*. Accordingly, Appellants/Applicants respectfully submit that *August* cannot properly be relied upon for disclosing the above features.

Favorable review and reversal of the rejection under 35 U.S.C. § 102 are respectfully requested.

**A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN ESTABLISHED
AS THE OFFICE ACTIONS FAIL TO ESTABLISH THAT THE SECONDARY CITATIONS
CURE THE DEFICIENCIES OF THE REJECTION UNDER 35 U.S.C. § 102(B)**

Appellants/Applicants respectfully submit that the record fails to establish that the various secondary citations add anything that would remedy the above discussed deficiencies in the primary citation to *August*. Thus, each of the proposed combinations of citations fails to disclose each and every feature of the claims.

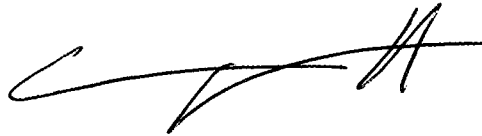
Favorable review and reversal of the rejections under 35 U.S.C. § 103 are respectfully requested.

CONCLUSION

In summary, Appellants/Applicants respectfully submit that claims 1-7 and 9-14 patentably define over the cited art. Reversal of the Examiner's rejections is respectfully requested.

Respectfully Submitted,

Dated: February 9, 2009

A handwritten signature in black ink, appearing to read 'Christopher Paul Mitchell', with a stylized flourish at the end.

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CLAIM APPENDIX

Claim 1 (Previously Presented): A method of controlling a set top box comprising:

providing a set top box that can be controlled by a telephone line coupled to the set top box;

receiving a telephone call from a calling party via the telephone line; and

controlling the set top box via at least one command transmitted by the calling party to the set top box during the telephone call, the controlling including directing the set top box to tune to a television event in accordance with the at least one command.

Claim 2 (Original): The method of claim 1 wherein controlling the set top box via at least one command transmitted by the calling party comprises receiving at least one predetermined number dialed by the calling party.

Claim 3 (Original): The method of claim 1 wherein controlling the set top box comprises disabling the set top box.

Claim 4 (Original): The method of claim 1 wherein controlling the set top box comprises enabling the set top box.

Claim 5 (Original): The method of claim 1 wherein controlling the set top box comprises directing the set top box to decrease a volume of a television set coupled to the set top box.

Claim 6 (Original): The method of claim 5 further comprising directing

the set top box to transmit an audio signal from the calling party over a speaker of the television set.

Claim 7 (Original): The method of claim 1 wherein controlling the set top box comprises directing the set top box to play at least an audio portion of a television event over the telephone line.

Claim 8 (Cancelled)

Claim 9 (Original): The method of claim 1 wherein controlling the set top box comprises directing the set top box to record a television event.

Claim 10 (Original): The method of claim 9 wherein directing the set top box to record a television event comprises directing the set top box to transmit a record command to a video recording device.

Claim 11 (Original): The method of claim 1 wherein controlling the set top box comprises directing the set top box to play a telephone message previously recorded by the set top box.

Claim 12 (Previously Presented): An apparatus adapted to employ a telephone interface comprising:

a processor comprising computer program code adapted to control a set top box via at least one command transmitted by a calling party over a telephone line coupled to the set top box, the command being transmitted during a telephone call, the controlling including directing the set top box to tune to a television event in accordance with the at least one command.

Claim 13 (Original): A set top box comprising the apparatus of claim 12.

Claim 14 (Previously Presented): A computer readable storage medium encoded with processing instructions for causing a processor to execute a method of controlling a set top box, the method comprising:

controlling a set top box via at least one command transmitted by a calling party over a telephone line coupled to the set top box, the command being transmitted during a telephone call, the controlling including directing the set top box to tune to a television event in accordance with the at least one command.

EVIDENCE APPENDIX

Not applicable

RELATED PROCEEDINGS APPENDIX

Not applicable